



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/680,088	10/08/2003	Toshiki Taguchi	Q77899	4445
23373	7590	08/09/2005	EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			LIANG, LEONARD S	
			ART UNIT	PAPER NUMBER
			2853	

DATE MAILED: 08/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/680,088

Applicant(s)

TAGUCHI, TOSHIKI

Examiner

Leonard S. Liang

Art Unit

2853

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 3, 4, 7, 8, 10 and 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5 and 6 is/are rejected.
- 7) ☒ Claim(s) 9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/08/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

The response to election/restriction filed on 07/15/05 is noted and appreciated. The applicant has elected to prosecute Species I without traverse. Claims 1-2, 5-6, and 9 are directed to Species I. All other claims will be withdrawn from consideration.

Specification

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Ohya et al (US PgPub 20010023652 A1).

Ohya et al discloses:

- {claim 1} An inkjet recording method comprising ejecting ink droplets on an image-receiving material according to recording signals to record an image on the image-receiving material, wherein at least one of the ink and the image-

Art Unit: 2853

receiving material comprises an acid precursor capable of releasing an acid by a chemical reaction (paragraph 0146, 0157-0162)

- {claim 2} wherein one of the acid precursor and a compound which reacts with the acid precursor to release an acid is contained in the ink, and another one of the acid precursor and the compound is contained in the image-receiving material (paragraph 0146; 0157-0162)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohya et al (US PgPub 20010023652 A1) in view of Sobieski (US Pgpub 20040071953 A1).

Ohya et al discloses:

- {claims 5-6} an inkjet recording method (as applied to claims 1-2 above)

Ohya et al differs from the claimed invention in that it does not disclose:

- {claims 5-6} wherein at least one ink containing the acid precursor is a colorless ink having substantially no absorption in a visible light region

Sobieski discloses:

Art Unit: 2853

- {claims 5-6} an acid precursor containing a white pigment (paragraph 0022 and 0044; here a white pigment can be broadly considered a colorless ink having substantially no absorption in a visible light region)

It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teachings of Sobieski into the invention of Ohya et al. The motivation for the skilled artisan in doing so is to gain the benefit of increase the adaptability of the invention, so that any inorganic pigment can be used, even a colorless one.

Allowable Subject Matter

Claim 9 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 9 discloses “wherein the acid precursor is a compound comprising an atom which changes to a hard acid by the chemical reaction or an atomic group which changes to a hard acid by the chemical reaction, and the compound which reacts with the acid precursor to release an acid is a compound comprising a nucleophilic group,” which was not found, taught, or disclosed in the prior arts.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Taguchi (US PgPub 20040011247 A1) discloses an ink for inkjet recording, ink set for inkjet recording, and inkjet recording method.

Oda et al (US Pat 6492769) discloses an electron emitting device, electron source, image forming apparatus, and producing methods of them.

Titterington et al (US Pat 5380769) discloses reactive ink compositions and systems.

Ma et al (US Pat 5648405) discloses aqueous ink jet inks.

Matsumoto et al (US Pat 6030755) discloses an image forming method.

Rutland et al (US PgPub 20030202039 A1) discloses smudge-resistant ink jet printing.


Ito et al (US PgPub 20030097960 A1) discloses an ink composition.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leonard S. Liang whose telephone number is (571) 272-2148. The examiner can normally be reached on 8:30-5 Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Meier can be reached on (571) 272-2149. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

08/02/05
lsl LSL


8/3/05
MANISH S. SHAH
PRIMARY EXAMINER